

### Remarks

In the Office Action mailed July 8, 1998, claims 1-8 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,314,187 to Proudfit. Claims 1-8 were also provisionally rejected for double patenting over claims 1-6 of copending applications Serial Nos. 08/870,585 and 08/926,246. Claims 1-8 remain pending.

#### **A. Claims 1-8 Are Patentable Over Proudfit**

A close reading of claims 1-8 reveals that each of these claims recites elements and aspects of the present invention golf balls that are not taught or described in the '187 patent to Proudfit.

Independent claim 1 recites, in part, a golf ball comprising an inner cover layer that includes a blend of two or more low acid ionomer resins containing no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid. Proudfit notes that blends of two or more types of ionomers "can be used" for the inner cover layer, col 6, lines 19-20. However, Proudfit fails to describe that if two or more ionomer resins are used, they should contain no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid.

Independent claim 1 further recites that the inner cover layer has a Shore D hardness of 60 or more. Proudfit entirely fails to teach or even suggest this aspect.

Independent claim 1 continues, and recites that the outer cover layer has a Shore D hardness of 64 or less, and that the Shore D hardness of the outer cover layer is less than the Shore D hardness of the inner cover layer. Proudfit, again, entirely fails to teach or even suggest this particular feature of the claimed golf ball.

Furthermore, Proudfit fails to describe or even suggest the particular combination of these features by themselves, and the combination of these features with other aspects of the claimed golf ball. Simply put, the '187 patent to Proudfit does not provide the necessary motivation and requisite teaching to arrive at the subject matter recited in claim 1..

Claims 2-6 all depend, or ultimately depend, from claim 1, and so,

contain all the recitations of that claim. In addition, these claims recite other features, that particularly when taken in combination with the elements of independent claim 1, are clearly distinguishable from the '187 patent to Proudfit. For at least these reasons, dependent claims 2-6 are all patentable over Proudfit.

Independent claim 7 recites, in part, a multi-layer golf ball comprising an inner cover that includes an ionomeric resin blend that comprises no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid, and which has a modulus of from about 15,000 to about 70,000 psi. Proudfit entirely fails to disclose this aspect of an inner cover layer. Moreover, Proudfit entirely fails to provide any type of teaching for this claimed modulus range.

Independent claim 7 further recites that the multi-layer golf ball comprises an outer cover layer including a particular blend of i) a sodium or zinc salt of a copolymer having from 2 to 8 carbon atoms and an unsaturated monocarboxylic acid having from 3 to 8 carbon atoms, and ii) a sodium or zinc salt of a terpolymer of an olefin having 2 to 8 carbon atoms, acrylic acid, and an unsaturated monomer of the acrylate ester class having from 1 to 21 carbon atoms. Where does Proudfit describe this claimed blend? The Examiner did not indicate where such description was found in the '187 patent.

Furthermore, claim 7 continues and recites a particular combination of Shore D hardness values and modulus ranges for the layers of the claimed golf ball. Specifically, claim 7 recites that the inner cover layer has a Shore D hardness of about 60 or more and has a modulus of from about 15,000 to about 70,000 psi, and that the outer cover layer has a Shore D hardness of about 64 or less and a modulus in a range of about 1,000 to about 30,000, and further that, this modulus is less than the modulus of the inner cover layer. Proudfit entirely fails to describe, teach, or even suggest this particular combination of properties.

Similarly, independent claim 8 recites, in part, a multi-layer golf ball comprising an inner layer that includes an ionomeric resin blend having no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid. As previously noted, Proudfit fails to describe this aspect.

Independent claim 8 further recites that the golf ball comprises an outer cover layer that includes a particular type of non-ionomeric thermoplastic. And,

claim 8 further recites that the outer cover layer has a modulus in the range of about 1,000 to about 30,000 psi. These features, especially in combination with another recitation of claim 8 - that the inner cover layer has a modulus of from about 15,000 to about 70,000 psi, are simply not described in the '187 patent to Proudfit. And, claim 8 contains a further recitation that the modulus of the outer cover layer be less than the modulus of the inner cover layer. These aspects, and particularly the combination of these features are simply not described, taught, or even suggested in the '187 patent to Proudfit.

**B. The Provisional Rejections**

Upon allowance of claims 1-8, Applicant will submit one or more terminal disclaimers as may be necessary in the two copending applications cited by the Examiner - U.S. Serial Nos. 08/870,585 and 08/926,246.

**C. Conclusion**

In view of the foregoing, Applicant submits that claims 1-8 are in condition for allowance.

Respectfully submitted,

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